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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,781	08/11/2000	Axel Burmeister	Beiersdorf 630-	8467

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	10

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/636,781	BURMEISTER ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 November 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *8-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-7* is/are rejected.

7)☒ Claim(s) *4* is/are objected to.

8)☒ Claim(s) *1-11* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This office action follows a response filed on November 25, 2002. Claims 1-3, 6, and 7 were amended.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,021,391 to Ijichi *et al.* for the same reasons set forth in the previous office action (see Paper No. 8).

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,760,135 to Korpman *et al.* for the same reasons set forth in the previous office action.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 58-7471 for the same reasons set forth in the previous office action.

5. Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,204,046 to Minatono *et al.* for the same reasons set forth in the previous office action.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,760,135 to Korpman *et al.* in view of U.S. Patent No. 3,956,223 to Chiang *et al.* for the same reasons set forth in the previous office action.

Briefly, Korpman *et al.* does not teach the use of plasticizing oils specifically, although the use of "oils" is contemplated (col. 4, line 64). The use of oils in pressure sensitive adhesive compositions is well-established in the art. For example, Chiang *et al.* show that naphthenic process oils are useful for building up the softness of the tack and to adjust flow properties and plasticity of pressure sensitive adhesives. In view of the references, it would have been obvious to one having ordinary skill in the art to use this particular material in the composition of Korpman *et al.*, and one would have expected such an modification to produce a useful pressure sensitive adhesive.

Response to Arguments

9. The Applicants traverse the following rejections under 35 U.S.C. 102(b):

(*i*) Claims 1, 2 and 5 as being anticipated by U.S. Patent No. 4,021,391 to Ijichi *et al.*

(*ii*) Claims 1-3 and 6 as being anticipated by U.S. Patent No. 5,760,135 to Korpman *et al.*

(*iii*) Claims 1 and 2 as being anticipated by JP 58-7471.

(*iv*) Claims 1, 2 and 7 as being anticipated by U.S. Patent No. 4,204,046 to Minatono *et al.*

The Applicant's arguments have been considered fully, but they are not persuasive. The Applicants comments hinge on the fact that neither of the cited references recites specifically the claimed value of 100 parts by mass of the non-thermoplastic elastomer component.

(*i*) Ijichi *et al.* indicates that the tackifier component is added in an amount of about 10-70 parts by weight per 100 parts by weight of total weight of liquid diene polymer and isocyanate compound (col. 5, line 34). Given a ratio of 0.75-1.2 equivalents of a polyfunctional isocyanate per equivalent functional group in the liquid diene polymer, the 10-70 pw tackifier still falls within the range claimed in the present claims.

(*ii*) Table A and the tables shown in the examples of Korpman *et al.* report the amounts of materials based on 100 parts by weight of the solid elastomeric component unless otherwise indicated (col. 5, line 55). The tackifier comprises 3-20 % by weight of the total weight of solid and liquid rubber (claim 10). This equates to the claimed amounts set forth in the present invention.

(*iii*) JP 58-7471 indicates that tackifier(B) is added in the amount of 10-1000 parts by weight per 100 parts by weight of rubber component (A) (see abstract).

(iv) Minatono *et al.* recites use of 10-250 parts by weight of tackifier per 100 parts by weight of liquid rubber component (claim 11).

That the amounts of materials disclosed in the references are based on 100 parts by weight of rubber component implies the existence of this amount. Actual numerical values may be readily scaled proportionately to reflect the use of 100 parts by weight of rubber component. As such, the subject matter of the present claims is met by the prior art. With regard to specific terminology, parts by weight is equivalent to parts by mass for all measurements made on Earth.

10. The Applicants traverse the rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Korpman *et al.* in view of U.S. Patent No. 3,956,223 to Chiang *et al.* The Applicant's arguments have been consideredfully, but they are not persuasive. The Applicants maintain that the skilled artisan would not obtain the present invention because Chiang *et al.* contemplates using oils with thermoplastic block copolymers.

The examiner respectfully disagrees with this notion. One would find it obvious to use process oils as per Chiang *et al.* for building up the softness of the tack and to adjust flow properties and plasticity of pressure sensitive adhesives of Korpman *et al.* One would expect the processing oil to work in this fashion regardless of the rubber material. The combination is obvious because both references relate to pressure sensitive adhesives and because the use of oils is contemplated in Korpman *et al.*

In view of the discussion above, the rejections of record have not been withdrawn.

11. The following have been withdrawn:

(*i*) Rejection of claim 3 under 35 U.S.C. 112, second paragraph.

(ii) Rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,932,558 to Kest *et al.*

(*iii*) Rejection of claims 1, 2, and 5 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,204,409 to Arend *et al.* in view of Ijichi *et al.*

(*iv*) Rejection of claims 1-3, 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,860,673 to Lawrence.

12. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

February 6, 2003

DAVID W. WU
SUPERVISORY PATENT EXAMINER
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